

Appl. No. 10/076,440  
Reply to Official Action mailed on 06/07/2006

### **Remarks/Arguments**

Claims 1-17 remain in the application. Claims 1-17 are rejected. Claims 1 and 14 are currently amended. Claims 15-17 have been cancelled.

### **Information Disclosure Statement**

Applicant wishes to note that a supplemental Information Disclosure Statement (IDS) was filed on July 11, 2006.

### **Telephone Interview Summary**

Applicant wishes to thank Examiner Ailes and Examiner Prieto for agreeing to the telephone interview of September 19, 2006. A complete and proper recordation of the substance of the telephone interview is provided, as follows:

- A) No exhibits were shown nor was any demonstration conducted.
- B) Claim 1 was discussed.
- C) The references discussed were Gropper (U.S. 6,883,000) and Schiller (U.S. 2001/0032089).
- D) No claim amendments of a substantive nature were proposed during the interview.
- E) During the course of the telephone interview, Applicant summarized the contents of the references that have been cited in the Office Action mailed on 06/07/2006, and then outlined the features of the invention as claimed at claim 1. In addition, Applicant argued that the proposed combination or modification of the teachings of Gropper and Schiller is unmotivated. Applicant referred to the Examiner's statement at page 5 of the office action mailed on 06/07/2006:

"one of ordinary skill in the art would have been motivated to implement this step in order for a user to be able to have an up to date contact database

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that is constantly being updated by the best person, the best person being the person who updates information in respect to themselves”.

Applicant disagreed with this statement, and noted that Gropper already teaches that the contact provides their own information to the server. Furthermore, Applicant noted that Gropper already teaches updating information (see column 7). In particular, the contact (which is referred to as “the subscriber” in the Gropper reference) provides updated information to the server, and then the server automatically updates the information to users that have previously downloaded that contact’s information. Applicant emphasized that Gropper teaches *inter alia* a system in which contact information is provided initially and is updated by the contacts themselves. Applicant stated that since Gropper already teaches each contact providing his or her own information to the server, there would have been no motivation, teaching or suggestion at the time of the invention that would lead one of skill in the art to make the combination or modification as proposed by the Examiner. In fact, as discussed, modifying Gropper such that update requests are sent in the form of electronic messages directly to the contact’s e-mail address, rather than always to the server system, would change the fundamental operating principle of the reference teaching. Indeed, the system would be rendered unsuitable for its intended purpose, which is to serve as an electronic yellow pages directory for allowing individual subscribers to advertise to others. The Examiners then suggested that Gropper could be modified such that update requests in the form of electronic messages are sent directly to the contact’s e-mail address, as well as to the server. This position seems to be based upon Applicant’s use of the transitional phrase “comprising”, which does not preclude steps in addition to those that are claimed. In response, Applicant noted that since Gropper already teaches that each contact provides their own information and update information, it would be redundant to send update requests in the form of electronic messages directly to the contact’s e-mail address, as well as to the server. Being redundant, one of skill in the art would not have been motivated to make such a combination at the time the invention was made.

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The Examiner raised a new question as to how the data stored in an electronic contact information database of a user system is recognized as data relating to a new contact. The Examiner further questioned how it is known that a contact is a "new contact", rather than simply an existing contact that has not updated their contact information for some period of time. These new questions were put aside during the interview, to be dealt with at the time of filing a formal response.

Finally, to the best of Applicant's understanding, Examiner Prieto stated that arguments relating to motivation to combine or modify the teachings of prior art references is a question to be left to the courts or the Board of Patent Appeals and Interferences. Due to the time constraint, Applicant did not respond to this assertion during the interview. In the event Applicant did not correctly understand Examiner Prieto's comment, clarification would be greatly appreciated.

- F) No other pertinent matters were discussed.
- G) No agreement was reached.

#### **Regarding Examiner's "Response to Arguments"**

Applicant thanks the Examiner for correcting the rejection format and for proceeding with the current non-final office action. The Examiner has addressed several key arguments that were presented in the communication dated March 24, 2006. Applicant wishes to comment on some of the Examiner's statements at this time.

Regarding point 4, Applicant agrees with the Examiner's statement "that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art." 35 U.S.C. 103 requires that obviousness must be assessed "at the time the invention was made". The use of hindsight reasoning, derived from teachings contained in the instant application, is impermissible. It

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is precisely this reason that some teaching, suggestion, or motivation is required. Never the less, the Examiner states:

"Gropper clearly teaches a contact information database and Schiller clearly teaches a method for updating a contact information database, therefore the examiner maintains that one of ordinary skill in the art would have been motivated to combine the teachings in order to provide an up to date contact information database as outlined below and by Schiller."

Firstly, Applicant submits that such a broad statement does not adhere to the principles for assessing obviousness as outlined in *Graham v. John Deere Co.* In particular, this statement fails to properly "determine the scope and contents of the prior art", seeking merely to distill the teachings of each reference down to a handful of broad terms. For instance, the statement "Gropper clearly teaches a contact information database" is misleading, overly simplified, and does not meaningfully reflect the scope and contents of this 44 page-long document. Furthermore, there appears to have been no discernable attempt by the Examiner to ascertain the differences between the prior art and the claims in issue. Applicant also wishes to ensure that the basic considerations which apply to obviousness rejections are observed. For certainty, these considerations are:

- A) the claimed invention must be considered as a whole;
- B) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- C) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- D) reasonable expectation of success is the standard with which obviousness is determined.

Regarding point 5, Applicant respectfully submits that Gropper merely teaches at col. 6, lines 54-57 that a contact may, of their own initiative, perform change of address or other information update operations in the event that some of their information changes. In such a case, the contact would provide updated information to the server, and the server would subsequently provide the updated information the next time a user causes their client application to connect to the server system. Of course, this is not what is claimed at claim 6 currently on file. In fact, claim 6 recites:

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“A method according to claim 5 comprising the steps of: verifying the authenticity of each electronic message received at a system of the new contact.”

Gropper does not teach verifying the authenticity of each electronic message received at a system of the new contact. In fact, to the best of Applicant's knowledge, Gropper is entirely silent as to an electronic message being received at a system of the new contact (that is to say, at a system of the subscriber). Since Gropper does not teach electronic messages received at a system of the new contact, clearly Gropper *cannot* teach verifying the authenticity of such messages. The change of address operation to which the Examiner refers does not teach or suggest the step that is recited at claim 6 currently on record, but merely serves to show that a subscriber may make periodic changes to their own stored information if desired.

Regarding point 6, Applicant acknowledges that figures 3 and 5 of Schiller appear to represent Microsoft Outlook screen shots. That being said, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In this case, Schiller teaches that incentives are offered to entice the existing contacts to update their information in response to messages that are generated automatically after passage of a set period of time.

Applicant submits that at the time the invention was made, one of skill in the art would have understood that incentives are necessary to encourage an existing contact to expend the time that is necessary to review, update and/or complete the information contained in the request message. Schiller does not explicitly or impliedly teach the use of any reply message functionality of Microsoft Outlook, even though it certainly would have been well known to Schiller. Furthermore, since Schiller clearly teaches that incentives are offered so as to entice the existing contacts to respond to the request message, then clearly there is no motivation, teaching or suggestion that would have led the skilled person at the time of the invention to implement such features as claimed at claim 9 currently of record.

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Regarding point 11, Applicant provides arguments that comply with 37 CFR 1.111(b) in the following section.

### Claim Rejections - 35 USC § 103

*Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gropper (US 6,883,000 B1) in view of Schiller (U.S. 2001/0032089 A1).*

Claim 1 has been amended to read as follows (where underlining indicates added text and double-square brackets indicates deleted text):

1. A method of adding a new contact to an electronic contact information database comprising the steps of:
  - a) using an application in execution on a user system, recognizing data stored in an electronic contact information database of ~~[[a]]~~ the user system as data relating to contact information of a new contact;
  - b) extracting from the stored data a contact destination of the new contact;
  - c) automatically sending a message including a request for additional contact information to the contact destination of the new contact; and
  - d) upon receiving a return message including additional contact information from the new contact, automatically updating the contact information database with the additional contact information.

The proposed amendment is made in order to address the Examiner's new question as to how the data is recognized as data relating to contact information of a new contact. An example of support for the proposed amendment may be found in the application as originally filed at paragraph [0034]. No new matter has been added.

Applicant fails to understand the apparent confusion regarding the term "new" contact. Nothing in the application as originally filed suggests that any special meaning is attached to the term "new", which is normally understood to mean "never existing before". The Examiner suggested during the telephone interview that an existing contact that has not updated their contact information for some period of time could be considered, in some sense, a "new" contact. Applicant fails to understand the rationale for making such a statement. Would not such a contact more properly be termed an "old" contact or perhaps simply an "existing" contact? In any event, Applicant respectfully submits that the term

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"new" contact is quite clear, and would be understood by one of skill in the art at the time the invention was made to mean a contact not previously existing in the user's electronic contact information database.

Applicant traverses the rejection of claim 1 as being unpatentable over Gropper in view of Schiller. In particular, Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness. At pages 4 and 5 of the Official Action mailed on 06/07/2006 the Examiner discusses briefly the scope and content of the prior art, making specific reference to the various features that are claimed at claim 1 as originally filed. Applicant respectfully submits that such an analysis fails to consider the prior art references as a whole, and is suggestive of impermissible hindsight. It appears to Applicant that the Examiner has read claim 1 of the instant application and, armed with knowledge obtained by reading the instant application, subsequently located references that teach (or are alleged to teach) the features as claimed. This disregards the requirement that obviousness be assessed as of the date the invention was made. It also disregards the requirement that the invention be considered as a whole. In particular, the question is not whether the differences *themselves* would have been obvious, but rather the *invention as a whole* would have been obvious (*Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983)).

In any event, Applicant has noted numerous portions of the Examiner's statement on pages 4 and 5 of the Official Action mailed on 06/07/2006 that are either inaccurate or misleading or both. Applicant has reproduced the relevant portions of pages 4 and 5 of the Official Action mailed on 06/07/2006.

"Gropper discloses a method of adding a new contact to an electronic contact information database comprising the steps of:

- (a) recognizing data stored in an electronic contact information database of a user system as data relating to contact information of a new contact (col. 5, lines 16-29, Gropper discloses a method of a user entering in a person or business' contact information using a Universal Contact Locator (UCL), which may be a person's e-mail address (see col. 4, lines 43-56). The client program automatically recognizes when a new contact's information is entered and stores the entered UCLs in a list.);
- (b) extracting from the stored data a contact destination of the new contact (col. 5, lines 37-41, Gropper discloses a method of extracting the UCL

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- of the new contact. The UCL providing information relating to the contact's contact destination.);
- (c) automatically sending a message including a request for additional contact information to the contact destination of the new contact. Gropper discloses a method wherein once the client station connects to the Internet the client station sends a request to the server for additional contact information linked to the contact's UCL (col. 5, lines 37-45) but does not explicitly disclose the request for additional contact information being sent directly to the new contact. However, Schiller discloses an operation of a contact database wherein update requests are sent in the form of electronic messages directly to the contact's e-mail address in order for the contact to be able to provide updated information. One of ordinary skill in the art at the time of the applicant's invention would have found it obvious to implement the step of sending a message directly to a contact requesting updated information as disclosed by Schiller in combination with the contact management database of Gropper. One of ordinary skill in the art would have been motivated to implement this step in order for a user to be able to have an up to date contact database that is constantly being updated by the best person, the best person being the person who updates information in respect of themselves (see Schiller, page 2, paragraph [0021]); and
- (d) upon receiving a return message including additional contact information from the new contact, automatically updating the contact information database with the additional contact information (col. 5, line 63 – col. 6, line 4, Gropper discloses the method wherein the server system sends a message back containing the appropriate information (the contact's additional contact information). Once this information has been received at the client, the contact data is stored in the appropriate locations (i.e. CMS, PIM).”).

**Under point (a) above, the Examiner states:**

“(col. 5, lines 16-29, Gropper discloses a method of a user entering in a person or business' contact information using a Universal Contact Locator (UCL); which may be a person's e-mail address (see col. 4, lines 43-56). The client program automatically recognizes when a new contact's information is entered and stores the entered UCLs in a list.);”

This statement is not accurate. In fact, Gropper merely teaches (see col 5, lines 16-41) “upon receipt of a business card or other social communication media which is encoded with a UCL, the recipient enters the UCL into the client program running on the client computer ... once the UCL(s) is entered into the client program, the client program will continue accepting and storing UCL(s) until such time as the user causes the client



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computer to establish an electronic (either wire or wireless) connection with the Internet ... the client program then passes the stored UCL(s) to the server system." Accordingly, Applicant respectfully submits that the client program does not automatically recognize when a new contact's information is entered. The client program merely accepts and stores UCLs, and then provides the stored UCLs to the server system. In support of this position, Applicant refers to col. 7, lines 19-23 where Gropper teaches "the server system maintains a contact list, herein referred to as a "UCL SUMMARY FILE" for each user of the present invention. The UCL summary file maintains a record of every unique UCL for which the user has down-loaded contact and advertising information to their client program." This statement implies quite strongly that the server system alone determines which UCL is new to a particular user and which UCL is existing.

As discussed *supra* Claim 1 has been amended to specify that an application in execution on a user system is used to recognize data stored in an electronic contact information database of the user system as data relating to contact information of a new contact. Gropper clearly does not teach this feature of amended claim 1, since it is only at the server level that the UCL SUMMARY FILE is used to determine which UCLs the user has entered previously.

**Under point (b) above, the Examiner states:**

"(col. 5, lines 37-41, Gropper discloses a method of extracting the UCL of the new contact. The UCL providing information relating to the contact's contact destination.);"

This statement is not accurate and is *particularly* misleading. While it is true that Gropper teaches receiving some social media encoded with a UCL, entering the UCL into the client program, and that the UCL may be an e-mail address of the contact (subscriber), still the UCL is not a "contact destination" of the contact. The meaning of "contact destination" is inferred at paragraph [0034] of the application as originally filed, where it is stated "preferably, the application extracts a contact destination, such as for instance an e-mail address of the new contact, and automatically transmits the electronic message to the extracted contact destination." Accordingly, the application as originally filed defines "contact destination" as the destination to which the electronic message including a request

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is transmitted. In contrast, Gropper teaches extracting an index key (UCL), which may be in the form of an e-mail address, the index key to be sent in a message to the server and used to look up information relating to the contact (subscriber). But the message from the client program including the UCL is always sent to the same destination, that being the server system. In fact, at col. 35, lines 38-43 Gropper states "the printing and/or encoding of the URL 1510 of the server system 130 will assist those recipients of business cards who are not at the time subscribers or registered users of the present invention to establish contact with the server system 130 for purposes of establishing a subscriber account or registered user account with the server system 130 that when the system becomes established, the client program." Accordingly, no combination or modification of Gropper in view of Schiller teaches the feature "extracting from the stored data a contact destination of the new contact" as is claimed at amended claim 1.

**Under point (c) above, Examiner states:**

"Gropper discloses a method wherein once the client station connects to the Internet the client station sends a request to the server for additional contact information linked to the contact's UCL (col. 5, lines 37-45) but does not explicitly disclose the request for additional contact information being sent directly to the new contact."

The Examiner goes on to state:

"However, Schiller discloses an operation of a contact database wherein update requests are sent in the form of electronic messages directly to the contact's e-mail address in order for the contact to be able to provide updated information. One of ordinary skill in the art at the time of the applicant's invention would have found it obvious to implement the step of sending a message directly to a contact requesting updated information as disclosed by Schiller in combination with the contact management database of Gropper. One of ordinary skill in the art would have been motivated to implement this step in order for a user to be able to have an up to date contact database that is constantly being updated by the best person, the best person being the person who updates information in respect of themselves (see Schiller, page 2, paragraph [0021]).;"

**Applicant does not concur. In fact, Applicant respectfully submits that the proposed combination is unmotivated.** For instance, Gropper clearly teaches at col. 3, lines 61-64, that the subscriber (e.g. issuer of business cards) provides all of his/her contact

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information to the server system. Accordingly, Applicant respectfully submits that one of ordinary skill in the art would not have been motivated at the time of the invention to make the proposed combination or modification, in view of the fact that Gropper explicitly teaches that the contact information *is* provided by the "best person," in this case the subscriber to the server system.

**Under point (d) above, the Examiner states:**

"(col. 5, line 63 – col. 6, line 4, Gropper discloses the method wherein the server system sends a message back containing the appropriate information (the contact's additional contact information). Once this information has been received at the client, the contact data is stored in the appropriate locations (i.e. CMS, PIM).)"

This statement is misleading, as it does not relate to any feature claimed at claim 1. The Examiner states that Gropper discloses the method wherein the server system sends a message back containing the appropriate information. Applicant agrees that this is true. However, this does not teach or suggest the feature that is claimed at amended claim 1, which recites (emphasis added) "upon receiving a return message including additional contact information from the new contact, automatically updating the contact information database with the additional contact information." Accordingly, Gropper does not teach or suggest the feature that is claimed at point (d) of amended claim 1.

Applicant respectfully submits that there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art at the time the invention was made, to modify or combine the reference teachings as suggested by the Examiner.

Furthermore, the Examiner appears to be improperly distilling the invention down to a "gist of the invention", suggesting that the only difference is that Gropper does not send a message directly to the contact destination. Clearly, this is an oversimplification. According to amended claim 1, the contact destination of a new contact is extracted from data that is recognized as relating to the new contact, and a generated request message is transmitted to that contact destination. In contrast, Gropper teaches extracting index keys (the UCL) and sending a message including the index key to the server system. The

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messages are always sent to the same destination, for instance the pre-assigned URL of the server system. The messages are not sent to destinations that are extracted from stored data relating to a new contact. Modifying Gropper such that messages are sent directly to the contacts, rather than always to the server system, would change the fundamental principle of the method that is disclosed. On the other hand, since Gropper already teaches that each contact provides their own information and update information, it would be redundant to send messages directly to the contacts as well as to the server. Clearly, when the invention is considered *as a whole* no combination or modification of Gropper in view of Schiller teaches each and every feature in as complete detail as is claimed at amended claim 1.

Accordingly, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness. Amended claim 1 is believed to be in proper condition for allowance, and Applicant respectfully requests favorable consideration.

Claim 2 depends directly from believed allowable amended claim 1. Applicant respectfully submits that no combination of Gropper and Schiller teaches "wherein the stored data is provided manually by a user of the user system" in combination with all of the features recited at amended claim 1. Accordingly, claim 2 is also believed to be in proper condition for allowance. Favorable consideration is kindly requested.

Claim 3 depends directly from believed allowable amended claim 1. Applicant respectfully submits that no combination of Gropper and Schiller teaches "wherein the stored data is provided automatically by an electronic message application in execution on the user system" in combination with all of the features recited at amended claim 1. Accordingly, claim 3 is also believed to be in proper condition for allowance. Favorable consideration is kindly requested.

Claim 4 depends directly from believed allowable amended claim 1. Applicant respectfully submits that no combination of Gropper and Schiller teaches "wherein the message is an electronic message and wherein step d) includes the step of: automatically extracting the additional contact information from the received return message" in combination with all of the features recited at amended claim 1. Accordingly, claim 4 is

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also believed to be in proper condition for allowance. Favorable consideration is kindly requested.

Having regard now to claim 5, Applicant respectfully submits that Gropper teaches exactly the reverse of what is claimed at claim 5. In particular, Gropper states at col. 3, lines 61-64, "In the present invention, a card holder (issuer) of business cards subscribes to a server system, thus becoming a subscriber, and provides all of his/her contact information to the server system." According to the terminology that is used by Gropper, it is the individual who is providing the contact information ("the new contact") that must subscribe to a service. Optionally, the user may or may not also be a subscriber, but the "new contact" always must be a subscriber, in order to obtain a UCL and in order to be able to provide their information to the server. While the user could conceivably use the client program as a general 'personal address book', they would have to rely entirely on manual entry of all contact information unless their contact is a subscriber with an associated UCL, stored data, etc. Accordingly, claim 5 is believed to be in proper condition for allowance. Favorable consideration is kindly requested.

Applicant traverses the rejection of claim 6 as being unpatentable over Gropper in view of Schiller. Claim 6 recites a step of "verifying the authenticity of each electronic message received at a system of the new contact." As discussed supra, Gropper merely teaches at col. 6, lines 54-57 that a contact may, of their own initiative, perform change of address or other information update operations in the event that some of their information changes. In such a case, the contact would provide updated information to the server, and the server would subsequently provide the updated information the next time a user causes their client application to connect to the server system. Gropper does not teach verifying the authenticity of each electronic message received at a system of the new contact. In fact, to the best of Applicant's knowledge, Gropper is entirely silent as to an electronic message being received at a system of the new contact (that is to say, at a system of the subscriber). Since Gropper does not teach electronic messages received at a system of the new contact, clearly Gropper *cannot* teach verifying the authenticity of such messages. Accordingly, no combination of Gropper and Schiller teaches every feature of the

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invention in as complete detail as is claimed at claim 6. Favorable consideration is kindly requested.

Having regard to claim 7, Applicant notes that no combination of Gropper and Schiller teaches verifying the authenticity of electronic messages received at the system of a new contact, and accordingly no combination of Gropper and Schiller can teach the additional features recited at claim 7. In particular, no combination of Gropper and Schiller teaches electronic messages comprising message body text containing contact information for at least one contact information field for verification. Claim 7 depends indirectly from believed allowable claim 1 and is also believed to be in proper condition for allowance. Favorable consideration is kindly requested.

Having regard to claim 8, Applicant respectfully submits that no combination of Gropper and Schiller teaches or suggests "wherein the return message is generated by an automated reply filter in execution on the contact system using contact information retrieved from a memory accessible to the automated reply filter". The Examiner correctly states at page 6 of the Official Action mailed on 07/06/2006 that Gropper discloses the method wherein a request for contact information is submitted to a **server system** and the **server system** automatically retrieves the requested contact information and submits the information back to the requesting system. However, the server system is *not* equivalent to the contact system. The server system of Gropper is a centralized system containing stored information relating to a plurality of contacts. In contrast, the contact system is a system that is local to the specific contact. In particular, the contact destination is the e-mail address of the contact, and so the contact system is one that at least temporarily provides the contact access to e-mail. Since the server system is not equivalent to the contact system, Applicant believes that claim 8 is in proper condition for allowance.

Applicant traverses the rejection of claim 9 as being unpatentable over Gropper in view of Schiller. In particular, it is respectfully submitted that the Examiner has not established a *prima facie* case of obviousness. Furthermore, in the case of claim 9 the Examiner has disregarded the requirement of analyzing the claimed subject matter "as a whole", by simply stating at page 4, item 10, "Claim 9 contains similar subject matter and

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is rejected under the same rationale as claim 1. Regarding the use of an inbox the method of storing messages within the inbox, Schiller discloses the use of an e-mail application to send and receive electronic messages...therefore it is deemed inherent for the e-mail application to include an e-mail inbox as is well known in the art." Applicant wishes to note that claim 9 recites a step of "using an automated reply filter cooperatively in execution with the electronic message application, intercepting the received electronic message **prior to storage thereof** within an inbox of the electronic message application." No combination of Gropper and Schiller teaches this step. In fact, the method of Schiller is based entirely upon offering incentives to contacts in exchange for updating their own contact information. Schiller teaches at paragraph [0021] "In an on-line managed database, the manager will preferably generate requests for updated information in the form of an e-mail message and send it to a respective individual's last known e-mail address. **The individual is then prompted to respond**, either with updated information or with a message that no update is necessary." Clearly, Schiller does not teach or suggest using an automated reply filter. Rather, the individual must access the electronic message in order to be **prompted** to respond. Furthermore, offering incentives if the individual responds to the generated request for updated information is only effective if the individual actually is aware of the incentive and actually desires to obtain the incentive. Imagine the effect of an automated reply filter implemented in the method of Schiller, the individual certainly would receive a flood of "junk incentives" because such a reply filter would respond to every request indiscriminately, regardless of the desirability of the incentive. Accordingly, Applicant respectfully submits that claim 9 is in proper condition for allowance. Favorable consideration is kindly requested.

Having regard to claim 10, Applicant argued *supra* that no combination of Gropper and Schiller teaches "using an automated reply filter cooperatively in execution with the electronic message application". Accordingly, no combination of Gropper and Schiller can teach "wherein the new electronic message is generated **by the automated reply filter** using contact information retrieved from a memory accessible to the automated reply filter." Accordingly, claim 10 is also believed to be in allowable form. Favorable consideration is kindly requested.

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Having regard to claim 11, Applicant respectfully submits that at the time the invention was made, it was inherent that message *intended* to be viewed by a recipient were stored in an inbox of an electronic messaging application. Subsequently, the recipient could move the message to another folder, such as trash, old, etc. Since Schiller teaches "the manager will preferably generate requests for updated information in the form of an e-mail message and send it to a respective individual's last known e-mail address. **The individual is then prompted to respond**, either with updated information or with a message that no update is necessary", it is inherent that the message is stored in the inbox. In particular, the individual must view the e-mail message in order to be prompted to respond, and accordingly the message would be stored in the inbox so as to be accessible to the individual. Accordingly, claim 11 is also believed to be in allowable form. Favorable consideration is kindly requested.

Claim 12 depends from believed allowable claim 9 and is also believed to be in proper condition for allowance. Favorable consideration is kindly requested.

Applicant traverses the rejection of claim 13 as being unpatentable over Gropper in view of Schiller. Claim 13 recites a step of "receiving at the user system a new electronic message generated by the automated reply filter." No combination of Gropper and Schiller teaches this feature. As discussed supra with reference to claim 9, the method of Schiller is based upon offering incentives to individuals in exchange for updating their own contact information. Schiller teaches at paragraph [0021] "In an on-line managed database, the manager will preferably generate requests for updated information in the form of an e-mail message and send it to a respective individual's last known e-mail address. **The individual is then prompted to respond**, either with updated information or with a message that no update is necessary." Clearly, Schiller does not teach or suggest using an automated reply filter. Rather, the individual must access the electronic message in order to be **prompted** to respond. Furthermore, offering incentives if the individual responds to the generated request for updated information is only effective if the individual actually is aware of the incentive and actually desires to obtain the incentive. Accordingly, Applicant respectfully submits that claim 13 is in proper condition for allowance. Favorable consideration is kindly requested.



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Claim 14 has been amended to include all of the features recited at claims 15-17 as originally filed. Applicant traverses the rejection of claim 14 as being unpatentable over Gropper in view of Schiller. The same arguments that were presented with reference to claim 1 also apply to claim 14 *mutatis mutandis*. Applicant further submits that no combination of Gropper and Schiller teaches "wherein the user is a subscriber to a contact list update service and wherein the new contact is other than a subscriber to the contact list update service". As was argued *supra* with reference to claim 5, Gropper states at col. 3, lines 61-64, "In the present invention, a card holder (issuer) of business cards subscribes to a server system, thus becoming a subscriber, and provides all of his/her contact information to the server system." According to the terminology that is used by Gropper, it is the individual who is providing the contact information ("the new contact") that must subscribe to a service. Optionally, the user may or may not also be a subscriber, but the "new contact" always must be a subscriber, in order to obtain a UCL and in order to be able to provide their information to the server system. While according to Gropper the user could conceivably use the client program as a general 'personal address book', they would have to rely entirely on manual entry of all contact information unless their contact is a subscriber with an associated UCL, stored data, etc. Accordingly, claim 14 is believed to be in proper condition for allowance. Favorable consideration is kindly requested.

Claims 15-17 have been cancelled.

A Petition for Extension of Time is filed concurrently with this response.

**Please charge any additional fees required or credit any overpayment to  
Deposit Account No. 50-1142.**

Respectfully submitted,



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